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**REMARKS**

Claims 1-29 are pending in the present application. Applicant has filed contemporaneously herewith a Request for Continued Examination. As such, Applicant presents and requests consideration of the above amendments and the following remarks in support of patentability.

In the Office Action mailed January 5, 2005, the Examiner rejected claim 16 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner also rejected claims 17-24 based upon their dependence upon a rejected base claim. Claims 8-15 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claims 1-2, 4-11, 13-15, 25, and 27 were rejected under 35 U.S.C. §102(b) as being anticipated by Academic Technology Services (ATS). Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over ATS in further view of Williams (USP 5,251,314). Claims 12 and 16-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over ATS in further view of Alam et al. (USP 6,336,124). Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over ATS and Alam further in view of Ouchi (USP 6,370,567). Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over ATS further in view of Chen et al. (USP 6,009,442). Claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over ATS in view of Ouchi. Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over ATS and Ouchi further in view of Williams.

**REJECTIONS UNDER §112**

The Examiner rejected claims 16-24 under §112 as being indefinite because claim 16 included the term "substantially." However, claim 16 has been amended to broaden the claim by removing terms including "substantially." As such, Applicant believes claims 16-24 are in full compliance with §112, second paragraph.

**REJECTIONS UNDER §101**

The Examiner rejected claims 8-15 under §101 as being directed to non-statutory subject matter. Though Applicant does not necessarily agree with the Examiner's interpretation of §101 or MPEP §2106, in an effort to expedite prosecution of an Application pending for nearly 5 years, Applicant has amended the claim to call for "A computer readable storage device having stored thereon a program that when executed by a computer causes the computer to...." As such, Applicant believes that the rejection of claims 8-15 under §101 has been traversed.

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**REJECTIONS UNDER §102****BACKGROUND**

The Examiner rejected claims 1-2, 4-11, 13-15, 25, and 27 under §102(b) as being anticipated by ATS. Applicant believes the above amendments clearly distinguish over the art of record. In particular, the above amendments clarify that the claimed invention is a system and method for publishing documents to a document management system using an application independent interface called from any of a plurality of applications. However, as will be shown, neither ATS nor anywhere in the art of record is the claimed invention taught or suggested.

Before addressing the claims in detail, Applicant believes it would be advantageous to further clarify the term "document management system" as used in the Specification and as commonly used in the information technology arts. That is, as described in the Background of the Invention Section, document management systems are prevalently used in business "to help manage the transfer of electronic information and actual document content between distributed authors/users." ¶6. These document management systems achieve this goal by requiring documents to only be used in a manner approved by the document management system.

For example, to retrieve documents from a document management system, a user must conform to a set of criteria or rules that the document management system is designed to enforce. In particular, a document management system typically requires that all documents of a given type have a uniform document title formats. As such, though a user may or may not be aware of all the document title formats that are acceptable for all of the different document types that may be managed by the document management system, the document management system aids the user in conforming to the rules or criteria the document system enforces.

To achieve effective management of all the various documents, document management systems typically employ a user interface that individuals use when wishing to access (retrieve or store) documents. As described in the Background of the Invention Section, to access the interface necessary to interact with the document management system from a given content authoring program, a button or menu option must added to the given content authoring program. See ¶¶ 5 and 6. However, this requires that any and all programs needing to interact with the document management system be augmented to include the button or menu. Furthermore, should the document management system require that the type of content attempting to be accessed by the authoring program be in a different format, the authoring program and the document management system will require a separate converter program before the desired data can be

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stored to or accessed from the document management system by the authoring program. Therefore, these systems may reduce efficiency and increase cost. See ¶6. As such, the claimed invention provides a system and method for publishing documents to a document management system using an application-independent interface that can be called from any of a plurality of applications that are capable of printing the document to be published.

On the other hand, as will be shown, nowhere does the art of record teach or suggest the claimed system and method for publishing documents to a document management system using an application independent interface called from any of a plurality of applications. For example, ATS merely teaches a system for generating a PDF document from any other document.

#### REJECTION

The Examiner rejected claims 1-2, 4-11, 13-15, 25, and 27 under §102(b) as being anticipated by ATS. When addressing claim 5, the Examiner asserted that “ATS discloses the method further comprising the step of transmitting the data file to a document management system capable of assigning a coded filename, a storage location, and a file identifier to the data file.” (Emphasis added). In support of the rejection the Examiner cited page 5, number 7 as teaching that “the file is saved to the hard drive in a document management system under a filename.” As such, it seems that the Examiner has not appreciated the specific meaning of a “document management system” as used in the Specification and as one of ordinary skill in the art would understand the term.

That is, page 5, number 7 merely teaches that by clicking “OK” in a dialog box designed to allow a user to convert a document (for example, a word-processing document) to a PDF, the user can enter a desired name for the PDF document that will be generated upon clicking “Save.” Then, once the “Save” button is clicked, the program (the well-known PDFWriter) stores the new PDF to the computer’s local hard drive. Nowhere does ATS teach or suggest a document management system. For example, in the case of claim 5, ATS does not teach or suggest a system “capable of assigning a coded filename, a storage location, and a file identifier to the data file.” Rather, ATS teaches away from a document management system by teaching that a user can select a desired document title without consideration of the requirements of a document management system.

It appears that the Examiner has not appreciated the specific meaning of a document management system and instead equated the document management system called for in claim 5 and amended claim 1 with a mere computer file system. However, the two are immediately

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recognized in the art as vastly different. While systems such as the Windows Operating System and the Macintosh Operating System referred to by ATS include computer file systems that allow users to save and retrieve data to and from a computer storage device, they do not include a document management system. That is, a computer file system allows the mere storage and retrieval of data from a computer storage device but does not manage the documents as a document management system does. Specifically, a document management system controls document publication parameters and/or document characteristics to ensure that the documents handled by the document management system all conform to a predetermined set of rules or criterion. By controlling document publication parameters and/or document characteristics, the document management system facilitates "the transfer of electronic information and actual document content between distributed authors/users" by allowing advanced search, notification, and retrieval operations to be performed that are not possible with out a document management system (i.e. with only a computer file system). ¶6.

Therefore, a computer files system is not the same as a document management system, as the Examiner appears to have concluded. Rather, a document management system is used to maintain documents within a computer file system by ensuring that documents published to the document management system conform to a set of organizational and usage criteria.

Therefore, claims 1, 8, and 25 have been amended to clarify that the claimed invention is configured to facilitate interaction document management systems. No new matter has been added. Accordingly, for at least the reasons addressed above, Applicant believes that claims 1, 8, and 25 are patentably distinct from the art. Furthermore, claims 2-7, 9-15, and 26-19 are in condition for allowance at least pursuant to the chain of dependency.

#### REJECTIONS UNDER §103

The Examiner rejected claim 16 as unpatentable over ATS in view of Alam et al. However, claim 16 has been amended to clarify that the claimed invention is configured to facilitate interaction with document management systems. No new matter has been added.

As explained above with respect to claims 1, 8, and 25, ATS does not teach or suggest operation and/or interaction with any document management system or the claimed interaction therewith. Rather, as explained, ATS actually teaches away from a document management system by allowing a user to "enter a name for your new PDF document" without consideration for the naming criterion enforced by a document management system. Similarly, Alam et al. neither teaches nor suggests any operation or interaction with a document management system.

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Rather Alam et al. is only concerned with the manipulation and display of data between document formats. See col. 1, lns. 52-56. In fact, Alam et al. never even uses the terms "manage" or "management."

For at least these and the reasons previously addressed with respect to claims 1, 8, and 25, claim 16 is patentably distinct from the art of record. While the Examiner rejected claims 17-24 under §103(a), Applicant respectfully disagrees with the Examiner with respect to the art as applied. However, in light of claims 17-24 depending from what is believed to be an otherwise allowable claim, Applicant does not believe additional remarks are necessary. Therefore, Applicant respectfully requests allowance of claims 17-24 at least pursuant to the chain of dependency.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-29.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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Dated: 3/30  
Attorney Docket No.: GEMS8081.072

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